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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/522,877      | 03/10/2000  | Gunther Durhammer    | 238-4               | 6082             |

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EXAMINER

FIORILLA, CHRISTOPHER A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 01/09/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                         |  |                     |  |
|------------------------------|-------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>  |  | <b>Applicant(s)</b> |  |
|                              | 09/522,877              |  | DURHAMMER, GUNTHER  |  |
|                              | <b>Examiner</b>         |  | <b>Art Unit</b>     |  |
|                              | Christopher A. Fiorilla |  | 1731                |  |

PL 10

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-24 is/are pending in the application.
- 4a) Of the above claim(s) 20-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

1. The disclosure is objected to because of the following informalities:

On page 3, line 31, it appears as though "cm2" should be changed to \*\* cm3 \*\* since a volume of air is being measured.

Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6-8,10-15 and 17-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Adams et al. (4,784,164).

Adams et al. teaches a layer of paper having a water repellent impregnation made from a cellulose derivative and a cigarette comprising a tobacco strand made therefrom, wherein said cellulose derivative provides air permeability of at least 20 CORESTA units. Adams et al. also discloses that the cellulose derivative may be ethyl cellulose (col. 5, line 54); the permeability may be greater than 50 Coresta units (col. 7, line 24); the cellulose derivative is applied in a quantity of at least 1 g/m<sup>2</sup> (e.g. col. 5, line 44 and col. 8, lines 55-60); the cellulose derivative is applied by a gravure process (col. 6, line 31); the cigarette is composed of only one layer of paper (see examples).

Note that in Example 3, the ethyl cellulose is dissolved in ethanol. According to applicant's arguments on page 4, line 2 of the amendment of November 4, 2002 and Exhibit "A" filed therewith, ethyl cellulose soluble in an organic solvent is not soluble in water and thus is water repellent as claimed.

Note again that the coating method is of no consequence since the claims are product claims and the method does not limit the metes and bounds of the claimed products.

Art Unit: 1731

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (4,784,164) in view of Ishino et al. (5,722,433).

Adams et al. teaches a layer of paper having a water repellent impregnation made from a cellulose derivative and a cigarette comprising a tobacco strand made therefrom, wherein said cellulose derivative provides air permeability of at least 20 CORESTA units. Adams et al. also discloses that the cellulose derivative may be ethyl cellulose (col. 5, line 54); the permeability may be greater than 50 Coresta units (col. 7, line 24); the cellulose derivative is applied in a quantity of at least 1 g/m<sup>2</sup> (e.g. col. 5, line 44 and col. 8, lines 55-60); the cellulose derivative is applied by a gravure process (col. 6, line 31); the cigarette is composed of only one layer of paper (see examples).

Note that in Example 3, the ethyl cellulose is dissolved in ethanol. According to applicant's arguments on page 4, line 2 of the amendment of November 4, 2002 and Exhibit "A" filed therewith, ethyl cellulose soluble in an organic solvent is not soluble in water and thus is water repellant as claimed.

Note again that the coating method is of no consequence since the claims are product claims and the method does not limit the metes and bounds of the claimed products.

Adams et al. does not specifically disclose applying the cellulose derivative on both sides of the paper.

Ishino et al. discloses that a coating composition may be applied to one or both sides (col. 10, line 37) of a cigarette paper to adjust the permeability thereof. It would have been obvious to

Art Unit: 1731

one having ordinary skill in the art at the time of the invention to apply the coating of Adams et al. to both sides of the paper in order to adjust the permeability thereof as desired in Adams et al.

6. Applicant's arguments with respect to claims 6-19 have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla whose telephone number is 703-308-0674. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in black ink, appearing to read 'ca Fiorilla', with a stylized flourish at the end.

**Christopher A. Fiorilla**  
**Primary Examiner**  
**Art Unit 1731**